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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,705	01/26/2001	Christopher S. Gouge	MS155721.2	6801

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EXAMINER	
INGBERG, TODD D	

ART UNIT	PAPER NUMBER
2124	6

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/770,705	GOUGE ET AL.
	Examiner	Art Unit
	Todd Ingberg	2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1 – 24 have been examined.

Grounds of Original Rejection Maintained.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 – 24 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. Template Software Corporation's product SNAP 8.0 released in 1997.

2. Template Software. The Template product line contains the SNAP programming language and the Workflow Template (WFT). The documentation sets for the products contain the following manuals.

SNAP released June 1997

SNAP Language Reference (Not used in this Office Action)

Using the SNAP Language (Not used in this Office Action)

Using the SNAP Communication Component (Not used in this Office Action)

Using the SNAP Graphic User Interface Component (Not used in this Office Action)

Getting Started with SNAP (Not used in this Office Action)

Using the SNAP Display Editors (Not used in this Office Action)

SNAP Class Library Reference (Not used in this Office Action)

Using the SNAP External Application Software Component (Not used in this Office Action)

Using the SNAP Development Environment (Referred to as **SNAP**)

SNAP Module Library Reference (Not used in this Office Action)

Using the SNAP Permanent Storage Component(Not used in this Office Action)

Workflow released September 1997

Developing a WFT Workflow System (Not used in this Office Action)

Using the WFT Development Environment (Not used in this section of the Office Action)

WFT Library Reference (Not used in this Office Action)

Since, these products work together they constitute a single reference and can be used as the basis for a rejection based on anticipated by a product offering.

Claim 1

SNAP 8.0 anticipates a configurable module (SNAP, Class editor, chapter 3) comprising:

(a) one or more configurable data elements (SNAP, page 3-40, attribute tab), wherein one or more default values (SNAP, page 3-40, default); for the one or more configurable data elements are available (SNAP, page 3-40, list of attributes);

(b) one or more non-configurable data elements describing the one or more configurable data elements(SNAP, page 3-62, const tab - constants); ; and

(c) one or more transformation instructions that facilitate configuring the one or more configurable data elements (SNAP, page 3-44, functions and getters and setters are inherent in Object Oriented programming).

Claim 2

The configurable module of claim 1, wherein the one or more configurable data elements are stored in a data structure associated with the configurable module (SNAP, Chapter 3 – class is a structure).

Claim 3

The configurable module of claim 2, wherein the data structure is a metadata item description table (SNAP, page 3-37, metadata from the "inherits from" feature).

Claim 4

The configurable module of claim 1, wherein the one or more non-configurable data elements are stored in a data structure associated with the configurable module. As per the rejection of claim 2.

Claim 5

The configurable module of claim 4, wherein the one or more non-configurable data elements are stored in a metadata item description table. As per the rejection of claim 3 meta data and the const of claim 1(b).

Claim 6

The configurable module of claim 1, wherein the one or more transformation instructions are stored in a data structure associated with the configurable module. As per the rejection of claim 2 the class is a structure with the functions in it.

Claim 7

The configurable module of claim 6, wherein the one or more transformation instructions are stored in a transformation instruction table. (SNAP, Function tab of claim 1(c) is an instruction table in the class structure).

Claim 8

The configurable module of claim 2 wherein the data structure includes at least one of a name of a configurable data element, and a semantic meaning for the configurable data element. (SNAP, page 3-40, "Name" of function).

Claim 9

SNAP 8.0 anticipates a data interpretation system, comprising: a data interpretation component adapted to receive one or more configurable data elements from a configurable module: apply one or more transformation instructions from the configurable module to the configurable data elements to configure the configurable data elements, and import the configurable data elements into a target data set. (SNAP, As per claim 1 above and emphasis on page 3-51 Rules tab and page 3-55 Demons Tab).

Claim 10

The system of claim 9, further comprising a user interface to enable a user to query the configurable module to determine which of the one or more data elements are configurable. (SNAP, Chapter 3 the class editor visibly has a GUI)

Claim 11

The system of claim 9 further comprising: a merging component adapted to receive one or more updated configurable data elements from the data interpretation component and adapted to provide the one or more updated configurable data elements to a target data set. (SNAP, rules as per claim 9 – target data set is the object created by the class structure as defined in the class editor).

Claim 12

The system of claim 9 further comprising: an authoring schema that describes a configurable module. As per claim 1 SNAP – class editor of chapter 3.

Claim 13

SNAP 8.0 anticipates a method for importing a configurable data set into a target data set, comprising obtaining one or more data elements from a configurable module; obtaining one or

more transformation instructions from the configurable module and applying the one or more transformation instructions to a copy of the one or more data elements from the configurable module to configure the one or more data elements. As per the rejection for claim 1.

Claim 14

The method of claim 13, further comprising: identifying a target data set; and inserting the updated data elements into the target data set. (SNAP, As mentioned above the target data set is the object created from the class structure above, as per claim 1).

Claim 15

The method of claim 13 further comprising: presenting one or more configuration options to a user; accepting one or more configuration selections from the user; and selectively configuring the one or more data elements based on the user's configuration selections. As per the rejection for claim 1 and COA page 2-36 to 2-37.

Claim 16

A computer readable medium containing computer executable instructions operable to perform the method of claim 13. (SNAP, functions as per rejection for 1c, Rules as per the rejection of claim 9, demons as per claim 9).

Claim 17

SNAP 8.0 anticipates a method for creating a configurable data module, comprising: creating a configurable data set having one or more configurable data elements; and creating one or more data structures containing information associated with one or more configurable data elements. As per the rejection of claim 1.

Claim 18

The method of claim 17 wherein creating a configurable data set includes: identifying one or more attributes of the one or more data elements; and establishing one or more default values for the attributes of the one or more data elements. As per the rejection of claim 1.

Claim 19

The method of claim 17 wherein creating the one or more data structures further comprises: identifying one or more locations within a data set that are configurable; identifying one or more configuration options; creating one or more instructions concerning how to configure the one or more locations; and storing the instructions in the one or more data structures. As per the rejection of claims 1 and 2.

Claim 20

The method of claim 19, wherein the one or more data structures are stored in the configurable data module. As per the rejection of claims 1 and 2.

Claim 21

A computer readable medium containing computer executable instructions operable to perform the method of claim 17.

Claim 22

SNAP 8.0 anticipates a system for importing a configurable data set into a target data set, comprising: a configurable module having configurable data elements representing a configurable data set and non- configurable data elements representing a portion of the configurable data set; a user interface for selecting which configurable data element to modify; and a data interpretation system for receiving the configurable and non-configurable data elements from the configurable module and applying the transformation instructions applicable

to the user selections associated with the configurable data elements to enable importing of the configurable data set to the target data set. As per the rejection of claims 1 and 2.

Claim 24

SNAP 8.0 anticipates a computer readable medium having stored thereon a data structure, comprising: a first data field containing one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available; a second data field containing one or more non-configurable data elements describing the one or more configurable data elements; and a third data field containing one or more transformation instructions that facilitate configuring the one or more configurable data elements. As per the rejection of claims 1 and 2.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 23 is rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. Template Software. The Template product line contains the SNAP programming language and the Workflow Template (WFT). The documentation sets for the products contain the following manuals.

SNAP released June 1997

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SNAP Module Library Reference (Not used in this Office Action)

Using the SNAP Permanent Storage Component(Not used in this Office Action)

Workflow released September 1997

Developing a WFT Workflow System (Not used in this Office Action)

Using the WFT Development Environment (Referred to as **WFT**)

WFT Library Reference (Not used in this Office Action)

Since, these products work together they constitute a single reference and can be used as the basis for a rejection based on anticipated by a product offering.

Claim 23

Template's product line of layer products with **SNAP 8.0** and **WFT** anticipates A data packet adapted to be transmitted between at least two computer processes, comprising: a configurable module having: one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available; one or more non-configurable data elements describing the one or more configurable data elements; and one or more transformation instructions that facilitate configuring the one or more configurable data elements. As per the rejection of claims 1 and 2. SNAP is a programming language which the Workflow Template (WFT) needs. WFT teaches a distributed object (A data packet adapted to be transmitted between at least two computer processes), as per WFT, page 2-2

Examiner's Remarks

4. Applicant has submitted claims to patent the basics of programming. Establishing variables with defaults and constants. The current claims read on the normal use of a high level programming language such as ANSI C, ANSI C++ or COBOL.

Response to Arguments

5. Applicant's arguments filed March 17, 2004 have been fully considered but they are not persuasive. The following argument's from the Applicant have been scanned into the Office action and might contain minor typographical errors as a result of the optical character recognition (OCR) operation involved.

Examiner's Observation

The rejection was written to the level of a Person Having Ordinary Skill In The Art (PHOSITA). Examiner notes the response does not meet this standard despite the presumption that all parties in the prosecution meet this level.

The level of skill against which obviousness is to be measured that of an ordinary person - not that of a judge, layman, one' skilled in another art, or a genius in the pertinent art. Environmental Designs Ltd. v. Union Oil Co., 218 USPQ 865 (Fed Cir. 1983).

The person of ordinary skill is a hypothetical person who is presumed to be aware of all the pertinent prior art (PHOSITA). Customer Accessories, Inc. v. Jeffrey-Allan Ind. Inc., 1 USPQ2d 1196 (Fed. Cir. 1986).

PHOSITA is one who is a designer or problem solver in the art. Orthopedic Equipment Co., Inc. v. U.S., 217 USPQ 193 (Fed. Cir. 1983); In re Wright, ,; In re Grout, 153 USPQ 742 (CCPA 1967) .

Applicant's Argument directed Toward Rejection of Claims 1-24 Under 35 U.S.C. §102(b)

"Claims 1-24 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Template Software Corporation's SNAP 8.0. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Template Software Corporation's SNAP 8.0 does not teach each and every element of the subject invention as recited in the subject claims. A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. Trintec Industries, Inc., v. Top-U.S.A. Corp., 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); See Verdegaal Bros. v_ Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir, 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)."

Examiner's Response

A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teaching (combination with his own knowledge of the particular art and in possession of the invention. In re Graves, 36 USPQ2d 169' (Fed. Cir. 1995); In re Sasse, 207 USPQ 107 (CCPA 1980); In Samour, 197 USPQ 1 (CCPA 1978). However, the Federal Circuit also held that anticipation is not shown where the difference, between the claims and the reference is minor and such as would suggest itself to PHOSITA. Connell v. Sears, Roebuck & Co., USPQ-193 (Fed. Cir. 1983); Structural Rubber Prod. Co. v. Pa: Rubber Co., 223 USPQ 1264 (Fed. Cir. 1984).

Applicant's Argument

"The subject invention discloses systems and methods for configuring software components. Specifically, independent claim 1 (and similarly independent claims 9, 13, 17, 22, 23, 24) recites a configurable module comprising one of more configurable and non-configurable data elements. Transformation instructions facilitate configuring the one or more configurable data elements. The one or more non-configurable data elements are utilized to describe the one or more configurable data elements. Template Software Corporation's SNAP 8.0 ("SNAP") does not teach or suggest such claimed elements of the subject invention.

More particularly, SNAP does not disclose non-configurable data elements that describe one or more configurable data elements. The Examiner cites SNAP, page 3-62 "Constants Tab" to teach this limitation. However, this page is not directed to non-configurable data elements that describe one or more configurable data elements, as recited in the subject claims. Rather, the "Constants Tab" includes the constant name, access levels and value of each constant. A constant is defined by Merriam Webster Dictionary as "something invariable or unchanging: as a number that has a fixed value in a given situation or universally or that is characteristic of some substance or instrument." Thus, constant values are non-configurable by definition and cannot be configured or changed by non-configurable elements, as recited in the subject claims."

Examiner's Response

The first basic concept that appears to not be within the grasp of the Applicant is the concept of what is an **object** in the field of object oriented technology. This is critical to understand since the Template product is an Object Oriented Computer Aided Software Engineering (OO-CASE) tool. One of very ordinary skill in the art should know an object is make of **attributes** (data elements both constants and/ or variables) and the **methods** (functions to perform operations on those attributes. Also, one of very ordinary skill in the art should know **class(es)** make up objects. The attributes and methods are defined in objects. An object is a configurable module. As to the configurable data element an attribute whose value can be changed is a configurable. When the object is instantiated the value is configured with a setter. A term well known in the art to one of very ordinary skill. Non-configurable data elements are met by the teaching of a constant. A setter can not change the value. The claim language has been met for a configurable module and the data elements that are configurable or non-configurable. Applicant's argument is not persuasive not does it appear to reflect the level of very ordinary skill in the art.

Applicant's Argument

"Moreover, SNAP does not disclose transformation instructions employed to configure the one or more configurable data elements. The Examiner cites page 3-44, "Functions Tab" to

teach such transformation instructions. However, the "Functions Tab" as described in SNAP is concerned with function information, function parameters and local attributes. The Functions Tab permits the user to view all the functions in a class, but does not allow the user to configure any of the data elements as required by the subject invention. In addition, the functions are not transformation instructions as disclosed iii the subject application. Instead, the getters and setters listed are used merely to identify and retrieve values, not to configure configurable data elements as recited in the subject claims. For example, as disclosed in the Function Tab, a function "GetByRmtSchema" is employed to retrieve an object graph from a remote SIB. Thus, such a function is not concerned with configuring configurable data elements, as recited in the subject claims."

Examiner's Response

The Function tab access the part of the OO-CASE tool where getters and setters are defined. The statement about "function information" does not reflect the actual teaching. In very simple terms it is where the methods are defined. Changing the value of an attribute is in fact a way to configure the attributes to one of very basic skill in the art. The Examiner also provided a teaching where a value can be set by an outside source. The source being from a data base and residing in a schema. The routine provided configures values in an object. Applicant's argument is not persuasive.

Applicant's Argument

"The Examiner relies on an incorrect interpretation of transformation instructions to read, via inherency, such instructions into SNAP. Specifically, the Examiner states that functions and getters and setters are inherent in Object Oriented programming and thus transformation instructions are inherently employed to configure configurable data elements. (Office Action, p. 4). However, as noted above, getters and setter are not the equivalent of transformation instructions and, therefore, the inherency conclusion drawn by the Examiner is erroneous. "To establish inherency, the extrinsic evidence `must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."' Continental Can Co. -v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (fed. Cir. 1991), The fact that a characteristic way be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because .inherency was [not] based on ... what was necessarily present in the prior art). Since SNAP does not disclose transformation instructions, as recited in the subject claims, but instead discloses functions, the missing descriptive is not necessarily present and would not be recognized by persons of ordinary skill. Thus, contrary to the Examiner's contention, SNAP does not disclose, expressly or inherently, transformation instructions, as recited in the subject claims."

Examiner's Response

Actually, the Examiner points at the basic principle of **inheritance** in object technology and it's role in another basic principle known as **instantiation** where classes are transformed into objects. During this process the object is configured. The basic concepts of object technology are not reflected in the arguments and are not deemed persuasive.

Applicant's Argument

"In addition, SNAP does not teach or suggest a method for importing a configurable data set into a target data set via obtaining one or more data elements and transformation instructions

from a configurable module and applying such instructions to a copy of one or more data elements from the configurable module to configure the one or more data elements. The Examiner cites the argument "as per the rejection for claim 1." However, there is no method taught in SNAP that relates to importing a data set, obtaining data elements and transformation instructions and applying such instructions to configure the one or more data elements, as required in the subject claims."

Examiner's Response

The argument that instantiation can not be removed from object technology as recited above answers this argument. Applicant's argument is not persuasive.

Applicant's Argument

"In view of at least the foregoing, it is respectfully submitted that SNAP neither anticipates nor suggests applicants' invention as recited in independent claims 1, 9, 13, 17, 22, 23 and 24 (and claims 2-8, 10-12, 14-16 and 18-21 which respectively depend therefrom), and this rejection should be withdrawn."

Examiner's Response

In view of the basic principles of object technology as presented above that one of very ordinary skill in the art must possess to be considered an ordinary artisan – the refernce anticipates the claimed invention.

Applicant's Argument

"Rejection of Claim 23 Under 35 U.S.C. $102(b)

Claim 23 is rejected under 35 U.S.C. § 102(b) based upon a public use or sale of the invention. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Template Software Corporation's SNAP 8.0 ("SNAP") does not teach each and every element of the subject invention as recited in the subject claims.

As noted above, SNAP does not teach or suggest a configurable module having one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available and one or more transformation instructions that facilitate configuring the one or more configurable data elements. Thus, it is of no consequence when SNAP was released since SNAP does not teach or suggest the subject invention as recited in the subject claims. Accordingly, this rejection should be withdrawn."

Examiner's Response

Applicant's arguments are the same as presented above and are wholly unpersuasive. A prima facie case of anticipation exists where the prior art contains all of the claimed structural limitations and the claimed functional limitations are inherent in the prior art structure even though the claimed invention recites a new and entirely different use. In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)..

Applicant's Argument

"Conclusion

The present application is believed to be in condition for allowance, in view of the above comments. A prompt action to such end is earnestly solicited."

Examiner's Response

Examiner's disposition is that the rejection stands. It does not appear the reference was understood to the level of one of ordinary skill in the art. The Examiner has provided a ***primer***

book on object technology and recommends Applicant's Representative communicate with the Inventor(s) prior to responding.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Todd Ingberg** whose telephone number is (703) 305-9775. The examiner can normally be reached during the following hours:

Monday	Tuesday	Wednesday	Thursday	Friday
6:15 – 1:30	6:15- 3:45	6:15 – 4:45	6:15-3:45	6:15-130

This schedule began December 1, 2003 and is subject to change.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Kakali Chaki** can be reached on (703) 305-9662. Please, note that as of August 4,

2003 the **FAX number** changed for the organization where this application or proceeding is assigned is **(703) 872-9306**.

Also, be advised the United States Patent Office **new address** is

Post Office Box 1450

Alexandria, Virginia 22313-1450

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

Todd Ingberg
Primary Examiner
Art Unit 2124
May 20, 2004